

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed June 18, 2003. In order to advance prosecution of this case, Applicants amend Claims 1, 11, 31, and 41. Applicants cancel Claim 42 without prejudice or disclaimer. Applicants add new Claims 56 and 57. The Applicants submit that the new claims do not add new matter and respectfully request reconsideration and favorable action in this case.

Claim Objections

The Office Action objected to Claims 1, 11, 31, and 41 because of the recited element: "generating process buffer data based on the MICR buffer". From the specification, it is clear that the "MICR buffer" recited in the claims refers to MICR buffer data. To correct any ambiguity, the claims are amended to recite "MICR buffer data". Applicants submit that the claims are not narrowed by this amendment and respectfully request withdrawal of these objections.

Section 102 Rejections

The Office Action has rejected Claims 1, 2, 4, 8, 11, 13, 17, 20, 21, 23, 27, 31, 32, 34, 38, 41, 42, 44, and 48 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,370,266 issued to Lau et al. ("*Lau*"). Applicants traverse this rejection for the reasons discussed below.

Claim 1 recites "generating process buffer data...the process buffer data standardized for a plurality of disparate types of check sorters." Applicants point out that *Lau* fails to disclose at least this aspect of the claimed invention for at least two reasons. First, the Office Action has interpreted language from *Lau*, referring to "application programs", to be read as "a plurality of types of check sorters." (Office Action 6/18/2003 p.4). However, *Lau* describes an "application program" as an executable program that controls "the operation of the devices lying along the document transport path" (col. 1, line 21 – 23); typical devices including "MICR readers, OCR readers, MICR encoders, programmable endorsers, and bank stamps" (col. 1, line 24 – 27); and the transport path being included in the "check processing transport" (col. 3, lines 30-32). Thus *Lau* describes a "check processing transport" that

utilizes "application programs" to control hardware devices including a "check sorter". There is no teaching of "standardized for a plurality of disparate types of check sorters" as recited in Claim 1. Second, the Office Action proposed that the "memory unit" disclosed by *Lau* should be read as the "process buffer" of Claim 1 (Office Action 6/18/2003 p.4). However, the memory unit is described in *Lau* as the hardware device where the operating system and the application programs are stored (*Lau*, col. 4, lines 14 – 22). Therefore, it is clear that the "memory unit" of *Lau* is not the "process buffer data" as recited by Claim 1. For at least these reasons, the rejection of Claim 1 is improper, and Applicants respectfully request withdrawal of the rejection and full allowance of this claim.

Independent Claims 11, 20, 31 and 41 are allowable for reasons analogous to those discussed above with respect to Claim 1. Accordingly, Applicants respectfully request withdrawal of the rejections and full allowance of these claims.

Dependent Claims 2, 4, 8, 13, 17, 21, 23, 27, 32, 34, 38, 44 and 48 are allowable as depending from allowable claims 1, 20, 31, and 41. Accordingly, Applicants respectfully request withdrawal of the rejections and full allowance of these claims.

Section 103 Rejections

The Office Action rejects Claims 3, 5-7, 9, 10, 12, 14-16, 18, 19, 22, 24-26, 28-30, 33, 35-37, 39, 40, 43, 45-47, and 50-55 under 35 U.S.C. § 103(a) as being unpatentable over *Lau* and U.S. Patent No. 5,790,260 issued to Myers ("*Myers*"). Applicants respectfully traverse the rejections and all findings and assertions therein.

As discussed above, *Lau* fails to teach all elements of independent Claims 1, 11, 20, 31 and 41 from which Claims 3, 5-7, 10, 12, 14-16, 18, 19, 22, 24-26, 28-30, 33, 35-37, 39, 40, 43, 45-47, and 49 depend. And the Office Action cites no teaching of the missing elements in Myers. Accordingly, Claims 3, 5-7, 10, 12, 14-16, 18, 19, 22, 24-26, 28-30, 33, 35-37, 39, 40, 43, 45-47, and 49 are allowable and Applicants respectfully request withdrawal of these rejections and full allowance of these Claims.

In regard to Claim 51, Applicants point out that neither *Lau* nor *Myers* disclose a “controller operable to control the digital imaging system to selectively image one or more of the front and the back of the check.” While *Lau* teaches to image a check during check processing, and *Myers* teaches to take images of the front and back of the checks, neither of these references teach a “digital imaging system to *selectively* image one or more of the front and the back of the check.” Rather, *Lau* teaches to capture an image of each check that is processed (*Lau* col. 3, lines 54 – 56); and *Myers* teaches creating a microfilm image of the front *and* back of each item (*Myers* col. 5, lines 64-65).

Additionally, the proposed *Lau-Myers* combination is inappropriate because the proposed modification would render *Myers* unsatisfactory for its intended purpose. *Myers* describes a system where the digital imaging system is separate from the check sorter and the digitizing process is performed “off-line” (*Myers* col. 5, lines 40 – 41 & col. 6, lines 38 – 40). A purpose of the *Myers* invention is to separate the digital imaging system from the check sorter, so as to eliminate the need to digitize the checks during the check sorting process. According to *Myers*, this results in higher quality digitized images, faster check sorting, and better post-digitization image enhancement. (*Myers* col. 6, lines 38 – 51). If *Myers* were modified by combination with *Lau*, the resulting check sorter would not have an off-line digitizing camera and would therefore not serve the intended purposes of the *Myers* invention. Accordingly, since the proposed modification would render *Myers* unsatisfactory for its intended purpose, there can be no suggestion or motivation to make the proposed *Myers-Lau* combination. See *MPEP* §2143.01. Applicants respectfully request withdrawal of the rejection and full allowance of Claim 51.

Independent Claim 54 is allowable for reasons analogous to those discussed above with respect to Claim 51. Accordingly, Applicants respectfully request withdrawal of the rejection and full allowance of this claim.

Dependent Claims 52, 53 and 55 are allowable as depending from allowable claims 51 and 54. Accordingly, Applicants respectfully request withdrawal of the rejections and full allowance of these claims.

To address deficiencies in the proposed *Lau-Myers* combination, the Office Action indicates that Official Notice was taken regarding several claims of the current invention. Specifically, the Office Action took Official Notice of certain aspects of Claims 9, 18, 28, 39, and 49 (Office Action, page 9). Applicants respectfully traverse the Official Notice of the Office Action. To the extent that any rejection is based on “Official Notice,” “well-known art,” common knowledge or other information within the Examiner’s personal knowledge, Applicants respectfully request that the Examiner cite a reference in support of his position or provide an affidavit in accordance with MPEP § 2144.03 and 37 C.F.R. § 1.104.

Conclusions

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending Claims.

To the extent the Examiner maintains any rejection, Applicants respectfully requests a telephone interview with the Examiner to discuss the rejection.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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